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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,391	01/28/2004	Anthony Di Bitonto	B0224.0079	2535
32172	7590	10/04/2007		
DICKSTEIN SHAPIRO LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) NEW YORK, NY 10036-2714			EXAMINER NGUYEN, PHONG H	
			ART UNIT 3724	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/765,391

Applicant(s)

DI BITONTO ET AL.

Examiner

Phong H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,16,17,20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,16,17,20 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

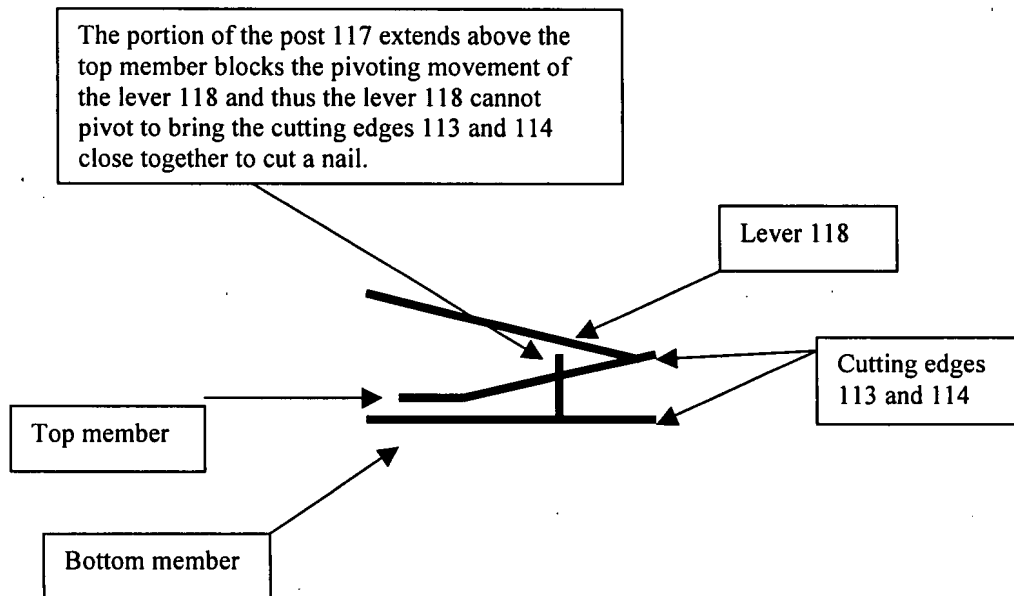
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 5-8, 16, 17, 20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 and 22, the original disclosure does not teach that the nail clipper in Fig. 5 can be operated with the lever 118 lacking a hole through which the post 117 in Fig. 4 extends. Therefore, it is unclear how the nail clipper in Fig. 5 can function with the claimed post. In a convention nail clipper as shown in Fig. 4, the lever 118 has a hole for receiving an end of the post 117 and pivots about the end of the post to cause the movement of the cutting edges 113 and 114. If the post just extends above the top member 101 and does not extend through the lever 118 as claimed in the Amendment dated 08/01/2007, the post blocks the pivoting movement of the lever, and thus blocking the movement of the cutting edge. See below sketch. In view of 35 USC 112 issues, claims 1, 5-8, 16, 17, 20 and 22 will be examined based on the assumption that the

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bumpers 119 and 120 will be provided in the nail clipper in Fig. 4, and the lever has a hole for receiving the post and pivots about an end of the post.



### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Litton (Des. 392,419) in view of Fink (3,169,312).

Regarding claims 1, 5 and 16, Litton teaches a nail clipper comprising top and bottom elongated members, a post, a lever and a bumper on a bottom surface of the bottom member. See Fig. 1.

Litton fails to teaches a pair of side surfaces connecting to the top elongated member and the bottom elongated member.

Fink teaches providing a pair of side surfaces 32 connecting to a top elongated member and a bottom elongated member for forming a house for storing cut-nail portions. See Figs. 1-8. Therefore, it would have been obvious to one skilled in the art to provide a pair of side surfaces as taught by Fink to the nail clipper of Litton for forming a house for storing cut-nail portions.

Regarding claim 8, the cutting edges are at an angle of 90 degrees with respect to a central longitudinal axis of the top and bottom elongated members.

5. Claims 1, 6, 7, 16, 17, 19, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsay (5,063,666) in view of Litton (Des. 392,419) and Fink (3,169,312).

Regarding claims 1, 16, 17, 19 and 22, Tsay teaches a nail clipper comprising top 31 and bottom 3 elongated members, a post 4 and a lever 2. See Fig. 1.

Tsay fails to teach providing a bumper on a bottom surface of the bottom member. Litton teaches providing a bumper on a bottom surface of the bottom member for comfortably gripping. Therefore, it would have been obvious to one skilled in the art to provide a bumper as taught by Litton on a bottom surface of the bottom member of the Tsay's nail clipper for comfortably gripping.

Tsay fails to teaches a pair of side surfaces connecting to the top elongated member and the bottom elongated member.

Fink teaches providing a pair of side surfaces 32 connecting to a top elongated member and a bottom elongated member for forming a house for storing cut-nail portions. See Figs. 1-8. Therefore, it would have been obvious to one skilled in the art to provide a pair of side surfaces as taught by Fink to the nail clipper of Tsay for forming a house for storing cut-nail portions.

Regarding claim 6, Tsay teaches the invention substantially as claimed except for a thumb accept depression on the lever. Litton teaches a thumb accept depression on a lever. See Fig. 1. Therefore, it would have been obvious to one skilled in the art to provide a thumb depression as taught by Litton on the lever surface of the Tsay's nail clipper for comfortably gripping.

Regarding claim 7, cutting edges of the Tsay's nail clipper are at an angle with respect to a central longitudinal axis of the elongated member.

Regarding claim 20, the bumper is best seen in Fig. 1 in Litton.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1, 5-8, 16, 17, 20 and 22 have been considered but are not persuasive in view of the 35 USC 112 rejection.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Timothy V. Eley/  
Primary Examiner, A.U. 3724

PN: 

September 28, 2007